

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 00565-069001
	Application Number 10/816,199	Filed March 31, 2004
	First Named Inventor Copeland et al.	
	Art Unit 3618	Examiner John Daniel Walters
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record <u>57,520</u> (Reg. No.)</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 50%; text-align: center;"> <p>_____ /Brenda Leeds Binder/ Signature</p> <p>_____ Brenda Leeds Binder Typed or printed name</p> <p>_____ (650) 839-5070 Telephone number</p> <p>_____ October 19, 2006 Date</p> </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.</p>		
<input checked="" type="checkbox"/> Total of 1 form is submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Copeland et al.	Art Unit :	3618
Serial No. :	10/816,199	Examiner :	John Daniel Walters
Filed :	March 31, 2004	Conf. No. :	7509
Title :	MICROSCOPE STORAGE SYSTEM		

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW IN REPLY TO ACTION OF APRIL 21, 2006

Pursuant to the Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. This pre-appeal brief is filed specifically in response to legal and factual deficiencies in the final Office Action mailed April 21, 2006. Nonetheless, all rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

I. The Examiner has Failed to Establish the Essential Elements for a *Prima Facie* Obviousness Rejection

The applicant respectfully submits the Examiner has failed to show a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings” [MPEP, §2143]. Second, to establish a case of *prima facie* obviousness, “there must be a reasonable expectation of success”. Third, “the prior art reference (or references when combined) must teach or suggest all the claim limitations” [MPEP, §2143]. With respect to each of the three independent claims, claims 1, 14 and 15, the prior art references when combined do not teach or suggest all the claim limitations.

Independent Claim 1

Claim 1 was rejected as allegedly being unpatentable over U.S. Patent No. 6,218,796 (“Kozlowski”) in view of U.S. Patent No. 6,112,414 (“Andis”). Claim 1 recites an apparatus having, *inter alia*, a base and a top, and a plurality of receptacles between the base and the top, each of the plurality of receptacles configured to house a microscope, where the receptacles are arranged **side by side one another** forming one or more rows, and a plurality of docking stations, where each of the plurality of **docking stations is configured to receive a battery-powered microscope** and

to recharge the battery of the battery-powered microscope and is positioned within one of the plurality of receptacles.

Kozlowski and Andis do not teach receptacles arranged side by side one another or docking stations configured to receive battery-powered microscopes. The Examiner rejected has failed to point out where Kozlowski or Andis teaches receptacles arranged side by side one another forming one or more rows. By contrast, Kozlowski teaches a cart 10 with vertically arranged shelves 18 (FIG. 1, col. 2, lines 20-34). The shelves 18 are stacked one on top of the other, but do not form receptacles that are arranged side by side. The Examiner argues that “[I]t would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to array multiple columns of receptacles, thus forming rows, in order to provide additional storage without increasing overall height of said cart.” (Office Action, page 3). However, Kozlowski shows that more than one laptop 16 can be stored on each shelf 18 (FIG. 1), (*i.e.*, in one horizontal layer) without indicating that receptacles would be required or desirable; there is no motivation for forming a plurality of receptacles that are arranged side by side one another in the same horizontal layer.

Further, neither Kozlowski nor Andis teach or suggest a docking station configured to receive a battery-powered microscope. Kozlowski does not show docking stations, but rather shows a shelf 18a that contains transformers 24 that can couple to the laptops 16. Andis teaches a battery charger 15 for a rechargeable battery-operated hair clipper 13 (FIG. 1, col. 6, lines 38-44), not a docking station configured to receive a battery-powered microscope. Combining Andis with Kozlowski would result in a cart with a number of battery chargers for rechargeable battery-operated hair clippers 13, which does not meet the limitations of claim 1.

By concluding that it would have been obvious to combine a battery charger for a rechargeable battery-operated hair clipper with Kozlowski’s cart to come up with the apparatus recited in the applicant’s claim 1, the Examiner has impermissibly used hindsight in an attempt to reconstruct the applicant’s invention. The Examiner is: (1) modifying the type of recharging device of Andis; (2) adding a plurality of receptacles that are arranged side by side one another and form one or more rows on the cart of Kozlowski; and (3) placing a plurality of the (modified) recharging devices in each of the receptacles. The Examiner does not provide motivation to make all of these modifications. The applicant submits that it is improper to use the applicant’s disclosure as the motivation to combine the particular teachings in the cited references. “The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure" See, M.P.E.P. § 214, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir.1991).

The applicant respectfully submits that, in any event, it is not necessarily desirable to modify Kozlowski's laptop storage cart with docking stations. Docking stations are typically specific to a particular make and model of a laptop computer. By integrating such docking stations into Kozlowski's storage cart, the cart would be limited to use with only particular makes and models of computers. As laptop computers are constantly changing and being rendered obsolete, having a cart adapted for use with only one particular make and model may be considered undesirable. Accordingly, not only are there features of the applicant's claim 1 that are not taught by the reference, there is no motivation provided in the references for modifying and combining the rechargeable clipper docking station of Andis with the cart of Kozlowski and there are legitimate reasons why such a combination may not be desirable.

The applicant respectfully submits a *prima facie* case of obviousness has not been established, as Kozlowski in combination with Andis fails to disclose all the limitations recited in claim 1 and the Examiner has impermissibly used hindsight in an attempt to reconstruct the invention cited in claim 1.

Independent Claim 14

Claim 14 was rejected as allegedly being unpatentable over Kozlowski in view of Andis and further in view of U.S. Patent No. 2,625,455 ("Mitten"). Claim 14 recites an apparatus having, *inter alia*, a plurality of receptacles . . . each . . . **configured to house a microscope** and arranged **side by side** one another forming one or more rows, wherein each row of receptacles is formed in a drawer positioned between the base and the top and slidable in a plane substantially parallel to the base and the top, wherein the drawer is slidable between an open position wherein the openings of the plurality of receptacles are exposed and the corresponding interior regions are accessible and a closed position wherein the openings of the plurality of receptacles are not exposed and the corresponding interior regions are inaccessible.

Kozlowski, Andis and Mitten in combination do not teach receptacles configured to house a microscope and arranged side by side one another forming one or more rows, wherein each row of receptacles is formed in a drawer, as required by claim 14. First, even in combination, Kozlowski

and Mitten do not disclose the apparatus recited in claim 14, as neither disclose a plurality of receptacles arranged side by side and forming one or more rows. Second, again, the applicant respectfully submits the Examiner has impermissibly used hindsight in an attempt to reconstruct the applicant's invention. It is improper to use the applicant's disclosure as the motivation to combine the particular teachings in the cited references. Although the concept of a chest of drawers was a well known concept at the time of Kozlowski's invention, Kozlowski did not disclose a device having drawers instead of shelves. The Examiner is using hindsight to modify Kozlowski's invention and the motivation for said combination is provided by the applicant's disclosure; this is an impermissible use of hindsight.

The applicant respectfully submits a *prima facie* case of obviousness has not been established, as Kozlowski in combination with Andis and Mitten fails to disclose all the limitations recited in claim 14 and the Examiner has impermissibly used hindsight in an attempt to reconstruct the invention cited in claim 14.

Independent Claim 15

Claim 15 was rejected as allegedly being unpatentable over Kozlowski in view of Andis and further in view of U.S. Patent No. 2,617,702 ("Manning"). Claim 15 requires, *inter alia*, a plurality of receptacles . . . arranged side by side one another forming one or more rows, each of the plurality of receptacles configured to house a microscope, wherein **each row of receptacles is formed in a drawer** positioned between the base and the top, **the drawer configured to pivot** between an open position wherein openings of the plurality of receptacles are exposed and the corresponding interior regions are accessible and a closed position wherein the openings of the plurality of receptacles are not exposed and the corresponding interior regions are inaccessible.

Kozlowski, Andis and Manning in combination do not teach a plurality of receptacles arranged side by side one another forming one or more rows, each row formed in a drawer configured to pivot. As noted above, Kozlowski and Andis fail to teach or suggest a row of receptacles. Manning teaches canister bin units and shows two bins side by side in a casing (FIG. 1). Each bin has its own pivotal support (See FIG. 1, cradle 27, pivot bar 24, and bracket elements 25 and col. 4, lines 1-4). When one bin is pivoted open, the other bin can remain closed. Claim 15, however, requires a plurality of receptacles arranged side by side one another forming one or more rows, where each row of receptacles is formed in a drawer configured to pivot between an open and

a closed position. The drawers of claim 15, which pivot open and closed, each have a plurality of receptacles. Manning does not teach or suggest a plurality of receptacles within the bins. Nor does the row of two bins, as shown in Manning, form a single drawer that opens and closes the bins together. Rather, Manning's bins are individually pivotable and do not form a drawer configured to pivot with a plurality of receptacles arranged side by side one another formed in the drawer.

Again, applicant submits that the Examiner is improperly using hindsight in an attempt to reconstruct the applicant's invention. In any event, a *prima facie* case of obviousness is not established as each and every limitation of claim 15 is not disclosed in the references, either alone or in combination.

II. Dependent Claims

A dependent claim is neither anticipated nor rendered obvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims (see *Hartness Int'l Inc. v. Simplimatic Eng'g Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987)). Accordingly, the applicant respectfully submits that claims 2-9, 12, 13 and 18-20, which depend from claims 1, 14 and 15 are allowable.

III. Conclusion and Relief

The rejections of record are clearly improper and without basis and should be withdrawn. Moreover, it is respectfully submitted that all of the claims are in condition for allowance, and a formal notice of allowance is respectfully requested. Please apply the three month extension of time fee (\$510.00), the notice of appeal fee (\$250.00) and any other necessary charges or credits to Deposit Account No. 06-1050. The fees in the amount of \$760 are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization.

Respectfully submitted,

Date: October 19, 2006_____

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